

the sum $a+b+c$ equals the oxidation state of M.
with the proviso that trichlorotitanium 8-quinolate, dichlorotitanium bis(8-quinolate), and monochlorotitanium tris(8-quinolate) are excluded.

REMARKS

Claims 22-35, 37-51, and 53-73 are pending. Favorable reconsideration is respectfully requested.

Claims 21, 36, and 52 have been rejected under 35 U.S.C. § 112, ¶ 1 as containing "new matter". These claims have been amended by rewriting as new claims 71, 72, and 73, to recite that in the definition of the group "L", the alkyl-substituted cyclopentadienyl ligand is a C_{1-6} alkyl-substituted ligand, and not a C_{1-16} alkyl-substituted ligand. Support is found in the disclosure, and in the claims as filed. The C_{1-16} group was inadvertently introduced due to a typographical error. Former claims 21, 36, and 52 have also been rewritten to include the proper quinolinyl structure rather than the naphthyl structure, again a typographical error. The dependent claims have been amended to correct their dependencies to new claims 71, 72, and 73. Withdrawal of the rejections of the claims on these bases under 35 U.S.C. § 112 is solicited.

Claim 52 has been rejected for excluding certain specific compounds from the scope of the claim, the Examiner deeming this limitation to be new matter. Applicants respectfully traverse.

The claimed catalysts and olefin polymerization processes employ a Markush group of catalysts having pyridinyl and quinolinyl groups as bidentate ligands surrounding a metal atom, the second attachment point for the bidentate ligand being an oxy, thio, amino, or phosphino group. The structure of the claimed catalysts is accurately set forth in claim 52 as amended.

The article by Fraser, "Reactions Of 8-Quinolinol With Covalent Halides, Part I. Tin and Titanium Tetrachlorides", J. CHEM. SOC. (A) 1966, pp. 544-49 was cited in the parent application and is thus of record. This reference appears to somewhat ambiguously disclose the three compounds excluded from the scope of claim 52, although no utility for these compounds is disclosed. Excluding compounds which may be anticipated from a claimed genus is not new matter, as clearly indicated by case law.

In the case of *In re Johnson*, 194 USPQ 187 (CCPA 1977), the Johnson et al. 1963 patent application had been involved in a three-way interference, as a result of which priority of a portion of the disclosed subject matter was awarded to another party. Johnson's original application described his claimed polymer as containing recurring -O-E-O-E'- units where E is a residue of a dihydric phenol and E' is the residue of a benzenoid compound. Johnson filed a CIP application following conclusion of the interference in 1972, some nine years after the U.S. parent application's priority date. The CIP claims contained the proviso that "E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei".

The Examiner rejected the claims under 35 U.S.C. § § 102/103 over the Netherlands published (1965) equivalent of the 1963 parent application, contending that the negative limitation in the "proviso" clause was not supported by the 1963 parent application, was thus new matter in the CIP, and the CIP claims thus not entitled to the filing date of the parent application under 35 U.S.C. § § 112 and 120.

The Board agreed, and affirmed the rejection. However, the CCPA reversed. The CCPA, citing *In re Wertheim*, 191 USPQ 90, 97 (CCPA 1976), stated:

Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable.

The court further stated:

To deny appellants the benefit of their grandparent application in this case would, as this court said in Saunders:

* * * let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was the first with the genus when he filed.

Finally, the court noted that:

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

Here, the situation is exactly analogous. The prior art may disclose certain species within Applicants' claim 52. As a result, Applicants have amended the claim to restrict the claim to avoid these species. Under the authority of *Johnson* and *Wertheim*, Applicants are entitled to do so. The proviso of claim 52 (now claim 73) is not new matter. Withdrawal of the rejection under 35 U.S.C. § 112 on this basis is solicited.

The Examiner has maintained the rejection of the claims under 35 U.S.C. § 102(e). Applicants respectfully request the Examiner to reconsider this rejection in view of the decision by the U.S. Supreme Court in *Hazeltine Research v. Brenner*, 382 U.S. 252 (1965). In *Hazeltine*, the claims of the Hazeltine patent were rejected under 35 U.S.C. § 103 through § 102(e) over a patent which had been copending but had subsequently issued. The patent disclosed, but did not claim, the subject matter claimed by *Hazeltine*. *Hazeltine* argued that the disclosure of a reference is ineffective as a reference under 35 U.S.C. § 103 since the rationale for the codification of Milburn-Bourneville by Congress embodied in § 102(e) was for purposes of anticipation only, as the Milburn case was an anticipation issue, not an issue for lack of invention (non-obviousness).

While the Supreme Court disagreed with *Hazeltine*, it did delineate the bounds for a proper rejection under 35 U.S.C. § 103 through § 102(e), by indicating that it is use of "unclaimed disclosure" that is proper in a rejection under § 103 through § 102(e).

In the present case, the additional subject matter disclosed and claimed in the present application is not the "unclaimed disclosure" of *Hazeltine*. Rather, the additional subject matter is not disclosed by the prior art *Nagy* patent at all. As the additional disclosure of the present application is not "unclaimed disclosure", it is not prior art under 35 U.S.C. § 102(e). *Hazeltine v. Brenner, supra*.

For the subject matter in common between the two applications, the disclosures are commensurate in scope. For this disclosure, Applicants are entitled to priority under 35 U.S.C. § 102, and *Nagy* is not a reference. For Applicants' additional disclosure, *Nagy* is not a proper reference under 35 U.S.C. § § 103/102(e) because the new subject matter is not "unclaimed disclosure" as required by *Hazeltine*. Thus, the rejection of the claims under 35 U.S.C. § 103 through § 102(e) must be withdrawn.

Entry of this amendment is respectfully solicited. The amendment was not presented earlier, as the rejections of the claims under 35 U.S.C. § 112 were not previously of record. Applicants submit that the amendments to the claims are such to remove all issues under 35 U.S.C. § 112 should appeal be necessary. Please charge the Petition for Extension of time fee and any additional fees or credit any overpayments as a result of the filing of this paper to Deposit Account No. 01-2230 -- a duplicate of this paper is enclosed for that purpose.

Applicants submit that the claims are now in condition for Allowance, and respectfully request a Notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the Application, he is highly encouraged to telephone Applicants' attorney at the number given below.

Respectfully submitted,

NAGY ET AL.

By 

William G. Conger

Registration No. 31,209

Attorney for Applicant

Date: September 13, 1999

Brooks & Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, Michigan 48075
Phone: (248) 358-4400
Fax: (248) 358-3351